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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,579	02/09/2001	Ulrich Daum	LP-1799	5245

7590

08/26/2003

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EXAMINER

OH, TAYLOR V

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 08/26/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/762,579

Applicant(s)

DAUM ET AL.

Examiner

Taylor Victor Oh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Final Rejection

The Status of Claims

Claims 6-21 are pending.

Claims 6-21 have been rejected.

Claim Rejections-35 USC 112

1. Applicants' argument filed 5/30/2003 have been fully considered but they are not persuasive.

The rejection of claim 6 has been withdrawn due to the modification made in the amendment. However, the rejection of claims 11, 13-15, and 18-19 has been maintained due to the failure to modify in the amendment.

Double Patenting Rejections

2. The rejection of Claims 6-8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 5,932,762 has been withdrawn due to the applicants' convincing argument.

Claim Rejections-35 USC 102

3. The rejection of Claims 6-13 under 35 U.S.C. 102(b) as being anticipated clearly by Woo et al (U.S.4,713,442) is maintained for the reasons of the record in paper no. 9.

Claim Rejections-35 USC 103

4. The rejection of Claims 14-21 under 35 U.S.C. 103(a) as being unpatentable over Woo et al (U.S.4,713,442) is maintained for the reasons of the record in paper no. 9.

In Response to the Argument

5. The applicants argue the following issues:
1. the Woo et al does not disclose any specific tricyclic aliphatic groups having an olefinic double bond ;
 2. the Woo et al does not show any exceptions to the requirement to use a catalyst as in the present invention;
 3. applicants' claimed unsaturated oligophenol cyanates have olefinic double bonds unlike to the compounds in the Woo et al;
 4. the Woo et al requires the catalyst in the preparation of the prepolymers or trizines or curing of the prepolymers unlike the present invention;

The applicants' argument have been noted, but these arguments are not persuasive.

First, with regard to the first and third arguments, the Examiner has noted applicants' argument. However, on the contrary to applicants' assertion, Claims 6 and 21 are broadly directed to the unsaturated oligophenol cyanates with olefinic double bonds or no double bonds in view of reviewing the passage of the claimed language , “ (i) R⁴ and R⁴” and (ii) R⁵ and R⁵” each , independent of one another, are either together a direct bond or are hydrogen and a bond to a group A. ” Therefore, the Woo et al is applicable to the claimed rejection.

Second, regarding the second argument, the Examiner has noted applicants'

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argument. However, the Woo et al teaches the preparation of one oligophenol cyanate by reacting one oligophenol with cyanogens chloride in the presence of a tertiary amine. This reads on Claim 8. Therefore, the Woo et al is relevant to the claimed invention.

Third, concerning the fourth argument, the Examiner has noted applicants' argument. However, applicants did not claim that the preparation of the prepolymers or trizines or curing of the prepolymers was conducted in the absence of any catalysts. Therefore, the Woo et al is relevant to the claimed invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. Victor Oh whose telephone number is (703) 305-0809. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman, can be reached on (703) 308-4698. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

T. Victor Oh

TV Oh
8/23/09

Alan L Rotman
ALAN L. ROTMAN
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